



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/714,637	11/16/2000	Kouichi Matsuda	203828US6	5346

7590

05/07/2003

OBLON SPIVAK MCCLELLAND MAIER & NEUSTADT  
FOURTH FLOOR  
1755 JEFFERSON DAVIS HIGHWAY  
ARLINGTON, VA 22202

EXAMINER

KAZMI, OMAR A

ART UNIT

PAPER NUMBER

2173

DATE MAILED: 05/07/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/714,637

Applicant(s)

MATSUDA, KOUICHI

Examiner

Omar Kazmi

Art Unit

2173

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☐ Claim(s) \_\_\_\_ is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 11/16/2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Information Disclosure Statement***

2. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered. The applicant is suggested to submit an information disclosure statement on form PTO-1449 disclosing a list of all patents, publications, or other information submitted for consideration by the Office and provide copies thereof.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 2-5, 6, 7, 9-11, 13, 14, 16, 18, and 19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
5. Claim 16 recites the limitation "connecting step" in the third line of claim 16. There is insufficient antecedent basis for this limitation in the claim.

Art Unit: 2173

6. Claims 2-5, 6,7, 9-11, 13, 14, and 16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite in regards to the term “and/or located within claims 2-5, 6,7, 9-11, 13, 14, and

16. The term “and/or” is interpreted as the term “or”.

7. Claims 18 and 19 are rejected, as they are identical in scope and language, as they both teach a program storage medium for imparting a virtual public telephone to a logged-in user in the form of an avatar.

***Claim Rejections - 35 USC § 102***

8. Claim 15 and 20 are rejected under 35 U.S.C. 102(e) as being anticipated by Liles et al. US Patent Number 5,880, 731, hereinafter referred to as Liles. Liles teaches a conversation support method and program storage medium for receiving a request for sending a message from an avatar, determining whether a destination of the message exists in shared virtual space and execution the connection processing in accordance with a decision made by a determining step as shown in Figure 12 and as described in Col. 12, lines 31-51, where shared virtual space can be interpreted as the proximity radius and the step of determining the destination is in a shared virtual space is made in step 234. Finally, Liles teaches about execution connection processing in accordance to a decision made by a determining step as seen in reference #236, 236, and 240.

9.

***Claim Rejections - 35 USC § 103***

10. Claim 1-4 and 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy et al., US Patent Number 6,219,045, hereinafter referred to as Leahy, and Linnett et al., US Patent Number 5,682,469, hereinafter referred to as Linnett. Regarding claims 1 and 8, Leahy teaches a conversation support system, method, and computer program with means for enrolling

Art Unit: 2173

an avatar of a log-in user into a shared virtual space as disclosed in the abstract and as well as Col. 14, lines 17-28, where Leahy teaches a means for enrolling as an avatar of a log-in user into shared virtual space. Also, Leahy teaches a means for determining in response to a user's message or call, determining whether a the message's party original exists in the shared virtual space as well as a means to execute a connection process in accordance with a decision made by the said determination means. Leahy teaches this in Col. 4, line 59 to Col.5, line 14, Col. 11, lines 1-16 and Col. 11, where a user determines whether the message from the user originated from the shared virtual space and delivering the message to be display into a graphical display. However, while he teaches this he fails to explicitly teach that the determining and connecting means is imported to a virtual mobile telephone to each avatar in the shared virtual space for the determining and connecting means. Linnett, however, teaches a means for imparting a virtual mobile telephone to an avatar in a shared virtual space. Linnett teaches this as described in the abstract, where a personal avatar is generated for each user in assisting the user in using the computer, and he also teaches a virtual mobile telephone in the form of a cell phone used within the virtual space as described in Col. 13, lines 9-17 which can be used to speed dial or communicate with other people or possibly other users. It is all clear that the virtual mobile cell phone allows the user to contact other users. Thus, it would have been obvious to one of ordinary skill in the art to modify the virtual world chat client-server system of Leahy to include the virtual mobile telephone of Linnett in order to obtain a virtual world chat client-server system with a virtual mobile telephone. One of ordinary skill in the art would have been motivated to modify the virtual world chat client-server system of Leahy to include a virtual mobile telephone of Linnett in order to provide the user a convenient metaphor for the user to contact other users.

Art Unit: 2173

Regarding claims 3, 4, 10, and 11, Leahy and Linnett teach that that if the calling party originated the call from another telephone in another virtual space, a connecting means establishes a connection with the telephone in another virtual space and/or executes message transfer as described in Leahy, Col. 11, lines 10-16. It is clear that Leahy and Linnett teach a connecting means receives the call from the telephone in the telephone from another virtual space and connects the received call to the virtual mobile phone of the called avatar in the shared virtual space via server 61.

11. Claims 2 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy and Linnett. While Leahy and Linnett teach a conversation support system and method as described in claims 1 and 8 above, they fail to explicitly teach a system and method wherein if the calling party originated from a telephone in the real world, the connecting step establishes a connection with the calling party through a public telephone network in the real world. However, it is obvious to one of ordinary skill in the art that users may log into an online chat with avatar environment through any means to connect to the Internet, including public telephone network via a modem. Thus, it is clear that if the calling party calls from a telephone or modem in the real world, it is obvious that there exists a connecting step that establish the connection with the calling party through a public telephone network in the real world; the examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art would to modify the conversation support system and method of Leahy and Linnett to include the connecting step from a telephone over a public telephone network to connect a calling party, which is notoriously well known in the art, to obtain a conversation support system with a connecting step from a telephone over a public telephone network to connect a calling

Art Unit: 2173

party. One of ordinary skill in the art would have been motivated to modify the conversation support system and method of Leahy and Linnett to include the connecting step from a telephone over a public telephone network to connect a calling party, which is notoriously well known in the art, in order to obtain a means to send a message from a calling party through conventional network to the Internet to facilitate online chat for users in an avatar system over the readily available connection means.

12. Claims 5-7, 12-14, 18, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy, Linnett, and Smith, "Adding 3D Visualizations to GIS". Regarding claims 5, 12, 18, and 19, Leahy teaches a conversation support system, method and computer program with means for enrolling an avatar of a log-in user into a shared virtual space as disclosed in the abstract and as well as Col. 14, lines 17-28, where Leahy teaches an means for enrolling as an avatar of a log-in user into shared virtual space. Also, Leahy teaches a means for determining in response to a user's message or call, determining whether a the message's party original exists in the shared virtual space as well as a means to execute a connection process in accordance with a decision made by the said determination means. Leahy teaches this in Col. 4, line 59 to Col.5, line 14, where a user determines whether the message from the user originated from the shared virtual space and delivering the message to be display into a graphical display. However, while he teaches this he fails to explicitly teach that the determining and connecting means is imported to a virtual a virtual mobile telephone to each avatar in the shared virtual space for the determining and connecting means. Linnett, however, teaches a means for imparting a virtual telephone to an avatar in a shared virtual space. Linnett teaches this as described in the abstract, where a personal avatar is generated for each user in assisting the user in using the computer, and he also teaches a

Art Unit: 2173

virtual mobile telephone in the form of a cell phone used within the virtual space as described in Col. 13, lines 9-17 which can be used to speed dial or communicate with other people or possibly other users. It is all clear that the virtual mobile cell phone allows the user to contact other users. However, while Smith teaches this, he fails to explicitly teach a virtual public telephone. However, Smith teaches a virtual mobile telephone as disclosed in his web page, "Adding 3D Visualization Capabilities to GIS". Here, Smith teaches telephone boxes in predetermined areas as seen in the lower and upper left figures on page 1 rendered in a 3D model of a VRML world as described on page 1, fifth paragraph. Thus, it would have been obvious to one of ordinary skill in the art to modify the virtual world chat client-server system with a virtual mobile telephone of Leahy and Linnett to include the public telephone of Smith in order to obtain a virtual world chat client-server system with a virtual public telephone. One of ordinary skill in the art would have been motivated to modify the virtual world chat client-server system of Leahy to include a virtual mobile telephone of Linnett in order to provide the user with natural real life manner to contact other users in an urban environment.

Regarding claims 7 and 14, Leahy, Linnett and Smith teach that that if the calling party originated the call from another telephone in another virtual space, a connecting means establishes a connection with the telephone in another virtual space and/or executes message transfer as described in Col. 11, lines 10-16 of Leahy. It is clear that Leahy, Linnett and Smith teach a connecting means receives the call from the telephone in the telephone from another virtual space and connects the received call to the virtual mobile phone of the called avatar in the shared virtual space.

Claims 6 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Leahy, Linnett, and Smith. While Leahy, Linnett, Smith teach a conversation support system and method as described in claims 5 and 12 above, they fail to explicitly teach a system and method wherein if the calling party originated from a telephone in the real world, the connecting step establishes a connection with the calling party through a public telephone network in the real world. However, it is obvious to one of ordinary skill in the art that users may log into an online chat with avatar environment through any means to connect to the Internet, including public telephone network via a modem. Thus, it is clear that if the calling party calls from a telephone or modem in the real world, it is obvious that there exists a connecting step that establish the connection with the calling party through a public telephone network in the real world; the examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art would to modify the conversation support system and method of Leahy, Linnett, and Smith to include the connecting step from a telephone over a public telephone network to connect a calling party, which is notoriously well known in the art, to obtain a conversation support system with a connecting step from a telephone over a public telephone network to connect a calling party. One of ordinary skill in the art would have been motivated to modify the conversation support system and method of Leahy, Linnett, and Smith to include the connecting step from a telephone over a public telephone network to connect a calling party, which is notoriously well known in the art, in order to obtain a means to send a message from a calling party through conventional network to the Internet to facilitate online chat for users in an avatar system over the readily available connection means.

Art Unit: 2173

13. Claims 16, 17, and 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Liles. Regarding claim 16, with respect to claim 15 above, Liles teaches a conversation support method for sending a message to an avatar, but he fails to explicitly teach if that if the destination of the message is found in the real world, the connecting step establishes connection with the destination through a public network in the real world. However, determining if the destination of the message is found in the real world, such as determining a computer's Internet protocol address or IP address to determine whether a message can be sent, and connecting the user's message to the destination to send a message through the a public telephone network such as a modem is notoriously well-known in the art and examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art to modify the avatar chat session system of Liles to include a way to determine if the destination is found in the real world and connecting through a public telephone network in the real world in order to obtain a avatar chat session where users can send messages from the real world through a public telephone network. One of ordinary skill in the art would have been motivated to modify the avatar chat session system of Liles to include the real world message through a public telephone network in the real world in order determine whether a message could be sent to a computer in the real world to a person in a virtual world, such as a member of an online chat session.

Regarding claims 17 and 21, Liles teaches a method and program storage medium for receiving a request for sending a message, determining whether the destination is in a shared virtual space and if the step is affirmative, sending a message to the avatar, as disclosed in Figure 12 and described in Col. 12, lines 30-51. However, while he teaches this, he fails to explicitly teach receiving the request from a source in the real space through a public telephone network in

Art Unit: 2173

the real world. However, sending a message such as a chat room or instant message over the Internet from a source in the real world (such as a user) through a public telephone network such as a modem is notoriously well known in the art and examiner takes OFFICIAL NOTICE of this teaching. Thus, it would have been obvious to one of ordinary skill in the art to modify the avatar chat session system of Liles to include the real world message through a public telephone network in the real world to obtain a avatar chat session where users can send messages from the real world through a public telephone network. One of ordinary skill in the art would have been motivated to modify the avatar chat session system of Liles to include the real world message through a public telephone network in the real world in order to provide users of telephone modems to connect through phone lines in order to exchange messages from the real world to a person in a virtual world, such as a member of an online chat session.

### ***Conclusion***

The prior art made of record on form PTO-892 and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 C.F.R. § 1.111(c) to consider these references fully when responding to this action. The documents cited therein teach inventions where a user may contact other users if they are not within the shared virtual world space as well as inventions relating to virtual telephones.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Omar Kazmi whose telephone number is 703-305-4894. The examiner can normally be reached on Monday - Friday 8 AM - 4:30 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Cabeca can be reached on 703-308-3116. The fax phone numbers for the

Art Unit: 2173

organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

OK  
May 5, 2003



JOHN CABECA  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100